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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,326

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Steffen Hasenzahl

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VENABLE LLP

P.O. BOX 34385

WASHINGTON, DC 20043-9998

EXAMINER

WELTER, RACHAEL E

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,326	Applicant(s) HASENZAHN ET AL.	
	Examiner RACHAEL E. WELTER	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/11/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/09 has been entered.

Claim Status

Claims 1-3 are pending. Claims 4-5 are cancelled.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on May 11, 2009 was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement was considered by the examiner. A signed copy of form 1449 is enclosed herewith. However, applicant should note that references DE 1467730 and EP 0566442 were not considered because no English translations of the references were provided. Furthermore, no International Search Report of PCT/US94/11510 was provided and was not attached with WO 95/11000. As such the search report was not considered.

Withdrawn Rejections

The rejection of claims 1-3 rejected under 35 U.S.C. 102(e) as being anticipated by Hasenzahl et al, Publication No. 2002/0197311 is withdrawn in light of a stronger rejection.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See page 9 of the instant specification. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al (US Publication No. 2002/0102369) as evidenced by Scholz et al (US Patent No. 6,951,642).

Shimizu et al teach a cellulose ester dope composition comprising Aerosil R 972V and benzoin (see paragraph 0272); example 21). As evidenced by Scholz et al, benzoin is a polymerization initiator used in moisturizing skin treatment compositions that aids in the copolymerization of (meth) acrylate and various comonomers (column 9, lines 53-61). Furthermore, as evidenced by the instant specification, Aerosil R 972V is a hydrophobic highly disperse silicon dioxide type that is particularly suitable for the composition (pg. 11, lines 19-27). As such, it is the position of the examiner that Aerosil R 972V exhibits the instant tamped density, water-wettable contents, and BET surface area.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (US Publication No. 2002/0102369) as evidenced by Scholz et al (US Patent No. 6,951,642).

The disclosure of Shimizu et al is discussed above.

Shimizu et al do not teach an amount of Aerosil R 972V that is from 0.01 to 30 wt.% but rather teach an amount that overlaps with the instant amount. Shimizu teaches that the silicon dioxide particles can be present in an amount of 0.005-0.3 wt.% (column 33, lines 45-48).

However, it would have been obvious to an artisan of ordinary skill at the time the invention was made to modify and optimize the amount of Aerosil R 972V in the composition of Shimizu et al. Optimization of parameters is a routine practice that would be obvious to a person of ordinary skill in the art to employ and reasonably expect success. One would have been motivated to determine the optimal amount of each ingredient in order to best achieve the desired results, which ultimately depends on the desired matting effect and transparency. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) & MPEP 2144.05.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebillotte-Arnaud et al (US Publication No. 2002/0039976).

Sebillotte-Arnaud et al teach a cleansing composition comprising at least one foaming surfactant, at least one hydrophobic silica, and at least one oxyalkylenated compound in a physiologically acceptable aqueous medium (paragraph 0011).

According to Sebillotte-Arnaud et al, the hydrophobic silica have a specific surface area ranging from 50-500 m²/g and a compacted density preferably from 50-150 g/L (paragraph 0021; Table 1). Sebillotte-Arnaud et al further teach that the hydrophobic silica can be an amount from 1-15 wt.% (paragraph 0018). Additionally, Sebillotte-Arnaud et al suggest that Aerosil R 972 can be used in the composition.

Although Sebillotte-Arnaud et al teach that the composition can comprise Aerosil R 972, Sebillotte-Arnaud et al do not teach a composition comprising Aerosil R 972V.

However, it would have been obvious to an artisan of ordinary skill at the time the invention was made to use a hydrophobic silica, such as Aerosil R 972V in the composition of Sebillotte-Arnaud et al. One would have been motivated to do so depending on the silica's desired compacted density and because Sebillotte-Arnaud et al suggest that the silica can have a compacted density in a range from 50-150 g/L.

Regarding the limitation, "wherein the silicon dioxide contains a maximum of 3.0 wt.% water-wettable contents," the examiner notes that Sebillotte-Arnaud et al teach hydrophobic silica. Furthermore, the instant specification provides evidence that Aerosil 972 exhibits water-wettable contents of 3 wt.% (see pg. 24, Table 6).

Conclusion

Claims 1-3 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHAEL E. WELTER whose telephone number is (571) 270-5237. The examiner can normally be reached 7:30-5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached at 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

REW

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
July 17, 2009